Remarks/Arguments

Claims 24-31, 40-41 remain in this application. In its Decision on Appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 24-31, 40 and 41, the Board vacated the Examiner's rejection under 35 U.S.C. §103 in view of a new ground of rejection under 37 CFR 1.196(b). The Board found that U.S. Patent 3,764,692, issued to Lowenstein (Oct. 9, 1973) anticipates the present invention under 35 U.S.C. §102(b). The Board submitted that Lowenstein discloses the single required step set forth in the claimed invention, "administering to the subject a composition comprising (-)-hydrocitric acid or a lactone form thereof, or a salt thereof, as active ingredient." The Board further submitted that Lowenstein also discloses that Garcinia cambogia is a source of (-)-hydrocitric acid, that lactone or sodium and potassium salt forms of this acid are useful in the method, and that (-)-hydrocitric acid or a lactone or salt form thereof can be added to food (e.g. Lowenstein, col. 2, lines 26-38). The Board conceded that Lowenstein does not discuss the concept of "enhancing exercise endurance in a subject undertaking exercise."

In response, Applicants have amended claims 24 and 25 to recite the effect achieved as a second step and to include the effect as part of the effective amount given to the subject. Support for this amendment is found on page 1, para. 2 of the specification, which defines "exercise endurance" to mean the ability to continuously perform a given physical work. Since the ordinary meaning of "work" is a purposeful activity (Webster's New World College Dictionary, 4th Edn. (2000) at 1649, the ability to continuously perform a particular

physical activity is included in the phrase "the ability to continuously perform a given physical work."

Anticipation requires that each and every element of the claims be disclosed, either expressly or inherently, in a single prior art reference or embodied in a single prior art device or practice. See In re Paulsen, 30 F.3d 1475, 1478, 31 U.S.P.Q.2d 1671 (Fed. Cir. 1994); Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565, 24 U.S.P.Q.2d 1321 (Fed. Cir. 1992). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. See Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991). Absence of any claimed element from the reference negates anticipation. See Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

Here, since Lowenstein neither discloses or suggests a method of enhancing exercise endurance in a subject undertaking exercise comprising administering to the subject an effective amount of a composition to enhance the exercise endurance of the subject and enhancing the ability of the subject to continuously perform a particular physical activity as claimed in claims 24 and 25, it cannot anticipate the present invention.

Since there is no prior art which teaches or suggests the claimed invention, Applicant respectfully requests that the Examiner withdraw all objections to and rejections of the present invention.

Applicant urges that this application is now in condition for allowance and earnestly solicits early and favorable action by the Examiner. If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned at 212-801-2100. The undersigned may also be contacted via e-mail at lubitb@gtlaw.com.

AUTHORIZATION

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-1561.

Respectfully Submitted,

Greenberg Traurig, LLP

By:

Date: October 6, 2003

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